ESTTA Tracking number: **ESTTA736248**

Filing date: **03/28/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86474701
Applicant	JJ206, LLC DBA JuJu Joints
Applied for Mark	POWERED BY JUJU
Correspondence Address	SHREYA BISWAS LEY LAYROOTS LLC 101 BROADWAY E#20182 SEATTLE, WA 98102 UNITED STATES shreya@layroots.com
Submission	Appeal Brief
Attachments	AppealBriefPoweredbyJUJU.pdf(127711 bytes)
Filer's Name	Shreya Biswas Ley
Filer's e-mail	shreya@layroots.com, support@layroots.com
Signature	/Shreya B Ley/
Date	03/28/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re:

JJ 206, LLC	)	Serial No.: 86474701
Applicant.	)	Mark: Powered by JUJU
	)	Date of Application: 12/08/2014

APPLICANT'S APPEAL BRIEF

Attorney for Applicant
Shreya B. Ley, Esq.
101 Broadway E, #20182
Seattle, WA 98102

TABLE OF CONTENTS

TABLE OF CASES

APPLICANT'S STATEMENT OF THE CASE

A. PROSECUTION HISTORY

On December 8, 2014 , Applicant filed an application with the United States Patent and Trademark Office for the word mark POWERED BY JUJU. On January 19, 2015, the Examining Attorney issued an Office Action refusing registration suggesting different wording for the description of goods and services, asking for a disclaimer of the word "JUJU," and alleging that the goods are in violation of the Controlled Substances Act. On July 15, 2015, Applicant filed a Response to the Office Action, amending the description of goods and services and providing argument in favor of registrability. On August 12, 2015, the Examining Attorney issued a Final Office Action, refusing registration. On February 8, 2016, Applicant filed a Notice of Appeal to Trademark Trial and Appeal Board, as well as a Request for Reconsideration of the Final Office Action to the Examining Attorney. On February 23, 2016, the Examining Attorney issued a Reconsideration Letter maintaining the denial on the basis of questioning the Applicant's lawful use in commerce.

B. EXAMINING ATTORNEY'S EVIDENCE

January 19, 2015 Office Action

The evidence attached to the Office Action included a screenshot from "Urban Dictionary" defining "JUJU."

August 12, 2015 Office Actions

Both issued office actions on this date had evidence consisting of online dictionary and "wiki" sources defining the word "JUJU."

February 23, 2016 Reconsideration Letter

No evidence was attached by the Examining Attorney in the Reconsideration Letter.

C. APPLICANT'S EVIDENCE

July 15, 2015 Response to Office Action

Applicant attached evidence in support of arguments including, a list of peer-reviewed studies demonstrating the medical benefits of marijuana, screenshots of trademark registrations from similarly regulated industries, and the Cole memo describing the Department of Justice priorities. Applicant further attached notices of allowance or registration certificates for marijuana-related businesses. Applicant also attached screenshots of dictionary definitions from Google, Merriam Webster, Urban Dictionary, and Wikipedia in support of "JUJU" having many alternative and more popular meanings.

February 8, 2016 Request for Reconsideration

Applicant attached a news article related to Applicant's goods. Applicant also re-attached the evidence attached in the July 15, 2015 response to office action and bolstered it with more registration certificates from businesses in similarly licensed industries.

QUESTION PRESENTED

Whether the Applicant's goods are registrable, in light of the Controlled Substances Act, even though the application in question is for the device, not any potential contents; even though the goods are being sold to lawfully regulated and licensed third parties; even though denying registration of the Applicant's goods would restrain commerce and cause consumer confusion; and even though marketing to or supporting an industry that may or may not be in violation of the Controlled Substances Act should not be and has not been a bar to registrability of goods or services.

ARGUMENT

I. THE APPLICANT'S GOODS ARE REGISTRABLE BECAUSE THE APPLICATION IS FOR THE DEVICE, NOT THE POTENTIAL CONTENTS.

The Applicant seeks registration of a device that is registrable, and does not seek registration for the future contents of the device in this Application. Whether or not the contents of the device are in violation of the Controlled Substances Act, as the Examining Attorney asserts, should not be the relevant question in this matter. The question of registrability should focus on the goods sought to be registered.

The Lanham Act has been interpreted to mean that any registered marks must be in "lawful use in commerce," which is often additionally defined as any commerce regulated by Congress. The Examining Attorney has cited the Controlled Substances Act to state that the Applicant's goods are not in "lawful use in commerce," which prohibits the "manufacturing, distributing, or dispensing" of any controlled substance, including marijuana. Furthermore, it has been stated that the Controlled Substances Act (CSA) prohibits any equipment, product, or material of any kind which is primarily intended or designed for use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under [the CSA]." 21 U.S.C. §863.

However, the Applicant's device should be considered in the same league as other oral vaporizing apparatuses, like e-cigarettes, in isolation from any proposed contents or the market to which the Applicant markets its goods. With the current popular opinion, the directives from the Department of Justice, and even from the medical community's stance on the issue, more and more businesses in support of the marijuana industry have emerged. Many businesses in support of this growing marijuana industry have received trademark protection because their services or goods are simply in support of or marketed to the industry (Table 1).

Table 1. Marijuana-related Businesses Awarded Trademarks (see *July 15 Response to Office Action and Feb. 8 Request for Reconsideration*)

MARK	**DESCRIPTION**
Ye Olde Dope Shop Ser. No. 86235836	Retail store services featuring marijuana and related consumer goods
Cannabis Energy Drink Reg. No. 79111928	Energy Drink and Sports Drinks, including Performance Drinks, not included in other classes, containing cannabis seed extract or mature cannabis stem extract
CCOP Reg. No. 86204665	Retail store services featuring hemp based products namely, edible hemp oil, candies, confectioneries, chocolate, tinctures, beverages, coffee, tea, cosmetics, shampoo, conditioner, salve, and vaporizers; providing consumer product information via the Internet; administration of reduced price program based on qualifying income, namely, administration of a discount program for enabling participants to obtain discounts on goods and services through use of discount membership; providing consumer information on reduced price wellness and health products and services
MJ Freeway Reg. No. 85319430	Computer services, namely, providing on-line non-downloadable web-based computer software for patient documentation and history, inventory control, and inventory management for use among medical marijuana centers, dispensaries, collectives, and patients.
MJardin	Industrial and engineering design services in the field of agriculture.

Reg. No. 86253368	Consulting in the field of agriculture.

The Applicant's goods should be treated no differently than those mentioned above in Table 1. The Applicant manufactures devices that are sold to and marketed to businesses and retailers who often sell marijuana-related merchandise in jurisdictions where this is a legal, regulated, and thriving industry. This device that supports these businesses is what the Applicant seeks registration for. Therefore, the Applicant's goods are registrable.

II. THE APPLICANT'S GOODS ARE REGISTRABLE BECAUSE THE GOODS ARE BEING SOLD TO A LAWFULLY LICENSED AND REGULATED INDUSTRY.

The Applicant's goods are in "lawful use in commerce" because the goods are being sold to lawfully registered, regulated, and licensed businesses and retailers. These legitimate business owners are encouraged to follow the laws of their jurisdiction or be subject to legal action. These business owners are regulated and licensed in their distribution or sale of the Applicant's goods and are free to fill the device with what they please. Many of these business owners are related to the marijuana industry; however, their jurisdictions comply with federal directives such as the *Cole Memo (*See *February 8, 2016 Request for Reconsideration, Exhibit A)*. The Applicant's goods are supporting these businesses and marketing to these business owners. Therefore, the sale of the Applicant's goods to these licensed and regulated business owners, who are operating in jurisdictions that allow for the sale and distribution of marijuana, which constitutes lawful use in commerce within the United States.

There are twenty-three states allowing the sale, distribution, possession, and dispensation of medical marijuana and the District of Columbia. Furthermore, there are four states and the District of Columbia that have legalized the sale, distribution, possession, and dispensation of marijuana, with seven additional states planning to put the legalization of marijuana on the ballot in 2016. These states, in one form or another, have enacted legislation allowing for the lawful use in commerce within their states concerning the medical and/or recreational use of marijuana. The Applicant's goods are sold to and marketed to businesses operating legally in these jurisdictions.

These businesses are taxed by the federal government and allowed to operate under the *Cole Memo*. If these businesses are considered to be taxable entities under the eyes of the Internal Revenue Service, and are given leave to operate under the Cole Memo, then the businesses marketing to and supporting these businesses should also be considered to be operating within the bounds of lawful commerce. Therefore, the Applicant's goods are in lawful use in commerce.

III. THE APPLICANT'S GOODS ARE REGISTRABLE BECAUSE DENIAL OF THE APPLICATION WOULD UNDULY RESTRICT COMMERCE BY CAUSING CONSUMER CONFUSION.

The Lanham Act defines a registrable trademark as any word, name, symbol, or design, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods. The Applicant seeks to register a combination of words for his goods that are in commerce to help distinguish his company's goods from other companies, as per the definition of a registrable trademark. The Trademark Examiner has agreed that the mark is an acceptable mark (*See Reconsideration Letter on February 23, 2016 and Office Action on August 12, 2015*). The remaining question of whether or not the goods are "in commerce" is argued in the other sections of this brief. However, the impact of not allowing this mark registration is contrary to the intent of the Lanham Act and should be considered.

The Lanham Act is meant to guard trademark owners against infringement and unfair competition, and, conversely, to guard the public against confusion and inaccurate information. (*See 15 U.S.C. § 1127. See, e.g., Wallace & Co. v. Repetti, Inc., 266 F. 307, 309 (2d Cir. 1920), cert. denied, 254 U.S. 639 (1920) ("In addition to the benefit accorded the owner of a trade-mark, it is the purpose of the trade-mark law to confer a benefit upon the ultimate consumer."); Birthright v. Birthright Inc., 827 F. Supp. 1114, 1133 (D.N.J. 1993) (stating that trademark law as embodied in the Lanham Act serves both the public interest "by protecting consumers from false and misleading representations concerning source, identity, or quality of product service" and the trademark owner by protecting "his or her product or service identified by a distinct name or label"))*. It was created to help protect the owner's property rights, and in an emerging market such as the one to which the Applicant markets and sells to, protection of property rights and source identification is particularly important.

The industry to which the Applicant markets and sells to is growing state-by-state and as more investors and corporations enter the market. There are few established brands within the market and, as consumers flock to the licensed and regulated retailers, they are already overwhelmed by the novelty of the market and then experience added confusion as to the source and quality of the goods that they are faced with. On the other hand, the companies, who are fighting to establish their brand within a new market, are often hurt by consumer confusion and emerging companies trading off of the goodwill that they have built in the emerging marketplace (where the marketplace is confusing, in part, due to its novelty). Denying the Applicant's application creates consumer confusion, allows for dilution of brand and quality, and opens the Applicant up to infringement, which is contrary to the purpose and intent of the Lanham Act.

Although there are state trademarks available to these companies, state trademarks offer an incomplete protection strategy. As the number of states legalizing cannabis either recreationally or medicinally, registering trademarks on a state-by-state basis becomes increasingly cost and time prohibitive. Furthermore, employing a state-by-state strategy for trademark protection creates risk for the company that their already established brand may be pre-empted in the new state by someone who submits an application prior to them. This creates a rush on the offices of each state as the companies scramble to register and ensure protections for themselves, unduly burdening the offices. It also erodes the property rights of the Applicant that are ensured by the Lanham Act to similar companies. Denying the Applicant's application places an undue burden on the companies and the state administrations. Additionally, denying the Applicant's application denies the property rights afforded to other, similar companies, to the Applicant just because of the market to which he markets and sells his goods to.

The Lanham Act was created with the intent to protect consumers and companies from this very predicament. The failure to register the Applicant's mark merely because of the industry to which they market and sell to erodes the purpose of the Lanham Act solely based on the regulated and licensed industry to which the Applicant markets and sells his goods to.

IV. THE APPLICANT'S GOODS ARE REGISTRABLE BECAUSE GOODS MARKETED TO, SUPPORTING, OR SOLD TO REGULATED INDUSTRIES ARE NOT PER SE BARRED FROM RECEIVING TRADEMARK PROTECTION.

Regulated goods and services have been afforded Federal trademark protection by the United States Patent and Trademark Office (USPTO). In 2010, the USPTO created a new class of goods and services for marijuana-related trademarks. The businesses and retailers to whom the Applicant's goods are marketed and sold to could be considered a regulated, not prohibited, industry similar to many of the industries afforded trademark protection and within the industry which the USPTO afforded trademark protection to in the past.

The Lanham Act defines a registrable trademark as any word, name, symbol, or design, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods." *See 15 U.S.C. § 1127*. "In commerce" has further been interpreted to refer to goods lawfully used in commerce where "commerce" has been defined as all commerce which may be lawfully regulated by Congress (*See Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 526, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987) (Stating that "[a] valid application cannot be filed at all for registration of a mark without 'lawful use in commerce'"); TMEP § 907; *see In*

re Stellar Int'l, 159 USPQ 48, 50-51 (T.T.A.B. 1968); *CreAgri Inc. v. USANA Health Sc. Inc.*, 474 F.3d 626, 630, 81 USPQ2d 1592, 1595 (9th Cir. 2007).)

However, exceptions have been made or trademarks awarded have been allowed to remain for goods that may not adhere to the definition of "lawful use in commerce." During Prohibition, when alcohol was not in lawful use in commerce, not only were some alcohol-related trademarks maintained, but some were also awarded during that time (See *February 8, 2016 Request for Reconsideration, Exhibit I, J*). Additionally, prescription drugs, regulated by the CSA, have been awarded trademark protection (See *February 8, 2016 Request for Reconsideration, Exhibit D)*. These prescription drugs are prescribed through the same channels as marijuana-related businesses in the twenty-three jurisdictions allowing medical marijuana.

Furthermore, according to the CSA *21 U.S.C. § 812*, in order for a drug to be considered for Schedule I placement, three criteria need be in place:

1. "The drug or other substance has a high potential for abuse.
2. The drug or other substance has no currently accepted medical use in treatment in the United States.
3. There is a lack of accepted safety for use of the drug or other substance under medical supervision."

If at least twenty-three states have determined that there is, in fact, accepted medical uses for marijuana, in addition to the 61 peer-reviewed medical journal articles listed, then it appears that there is an accepted medical use in treatment in the United States. In the more liberal of jurisdictions, the marijuana industry is similar to the alcohol and tobacco industry, both regulated, but able to receive trademark protection even in light of prohibition, at times.

The Applicant's goods are devices sold in similar channels to devices sold to prescription drug manufacturers or the alcohol and tobacco industries. The goods are being sold through legitimate, regulated, and licensed channels according to the rules of the state, often with a prescription from a doctor – the same doctors who prescribe other regulated pharmaceuticals. Because the Applicant's goods are available through the same regulated trade channels as many devices that are afforded trademark protection, the Applicant's goods should be deemed registrable.

CONCLUSION

The central question is whether the Applicant's goods are registrable in light of the Controlled Substances Act (CSA). For the foregoing reasons – that the Application is for the device, not the contents; should that not be reason enough, that the Applicant's goods are being lawfully sold in commerce; and lastly, that the Applicant's goods are being sold via regulated trade channels much like other regulated industries which have been afforded trademark protections – the Applicant's goods are clearly registrable, even in light of the CSA. For the foregoing reasons, the Applicant respectfully requests that the mark for Powered by JUJU be registered.